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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,051	12/06/2001	Yoshitaka Mishima	SHC0162	6019

35684 7590 05/23/2003

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EXAMINER

BOGART, MICHAEL G

ART UNIT	PAPER NUMBER
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3761

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DATE MAILED: 05/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/016,051

Applicant(s)

MISHIMA, YOSHITAKA

Examiner

Michael G. Bogart

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) 5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) ✓
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) / ✓
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 & 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restriction

This application contains claims directed to the following patentably distinct species of the claimed invention:

An absorbent article comprising skin-contactable sheets which is elastically stretchable;
and

An absorbent article comprising skin-contactable sheets which is non-stretchable.

Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to

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be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103(a) of the other invention.

During a telephone conversation with Michael Gzybowski on May 16, 2003, a provisional election was made with traverse to prosecute the invention of an absorbent article comprising skin-contactable sheets which are elastically stretchable, claim 4. Affirmation of this election must be made by applicant in replying to this Office action. Claim 5 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

— *Specification*

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-4 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1 at lines 7 and 8, recites a liquid absorbent panel (4) attached to a base sheet (3) and lying on a skin-contactable surface (1a). This limitation contradicts the disclosure of the specification, which in figure 4 shows the absorbent panel (4) as being juxtaposed on the **non** skin-contactable surface (1b) with the skin-contactable surface (1a) being located on the absorbent panel (4). The specification does not provide enabling disclosure to support this limitation.

Claims 2-4 are rejected as being dependent upon a non-enabled independent claim.

The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 at lines 7 and 8, recites a liquid absorbent panel (4) attached to a base sheet (3) and lying on a skin-contactable surface (1a). This limitation renders the claim indefinite, because the skin-contactable surface (1a) would not be skin-contactable if it lies under the absorbent panel (4). It is unclear what structural relationship between these elements that applicants intend to claim. For the purposes of examination against the art, the limitation will be interpreted as the absorbent panel is on the **non** skin-contacting surface, as described by the specification in figure 4.

Claims 2-4 are rejected as being dependent upon an indefinite independent claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 2 are rejected under 35 U.S.C. § 102(b) as being anticipated by Mishima *et al.* (EP 0 955 028 A2).

Regarding claim 1, Mishima *et al.* teach a disposable undergarment (1) comprising:

a skin-contactable surface (2);

a non skin-contactable surface (3) opposed to the skin-contactable surface (2);

a liquid pervious base sheet (3) contoured by longitudinally opposite end portions (11, 12) extending in a transverse direction and transversely opposite side edge portions (13) extending in a longitudinal direction (C-C);

a liquid-absorbent panel (4) attached to said base sheet (3) and lying on said **non** skin-contactable surface (3); and

skin contacting sheets (22) attached under extension in said longitudinal direction (C-C) to said skin-contactable surface (2) of said undergarment (1) so as to cover said liquid-absorbent panel (4), said skin-contactable sheets (22) being stretchable in said longitudinal direction (C-C) and substantially liquid-impervious, said skin-contactable sheets (22) having fixed surface areas (23, 24) secured to said longitudinally opposite end portions (11, 12) and free surface areas extending between said fixed surface areas (23, 24), which free surface areas are not fixed to said undergarment (1) so as to be spaced upward from said liquid-absorbent panel (4) as said

undergarment curves in said longitudinal direction (C-C) with its skin-contactable surface (2) inside,

said skin-contactable surface (2) of said undergarment (1) being provided with regions (27) in which said skin-contactable sheets (22) are absent so that said skin-contactable surface (2) inclusive of said liquid-absorbent panel (4) is partially exposed in said regions (27) in which said skin-contactable panels (22) are absent (see Fig. 2, below).

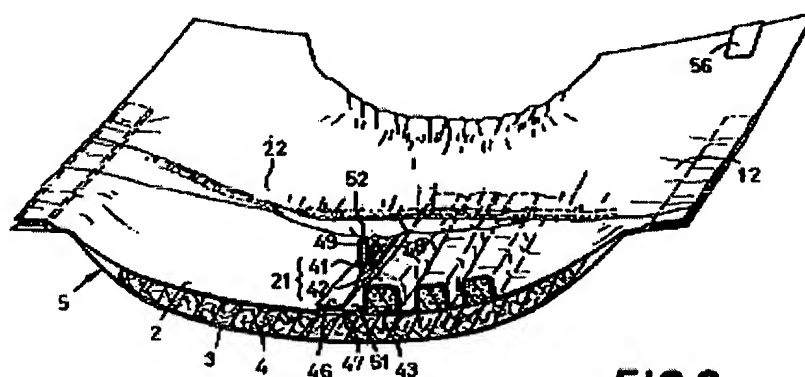
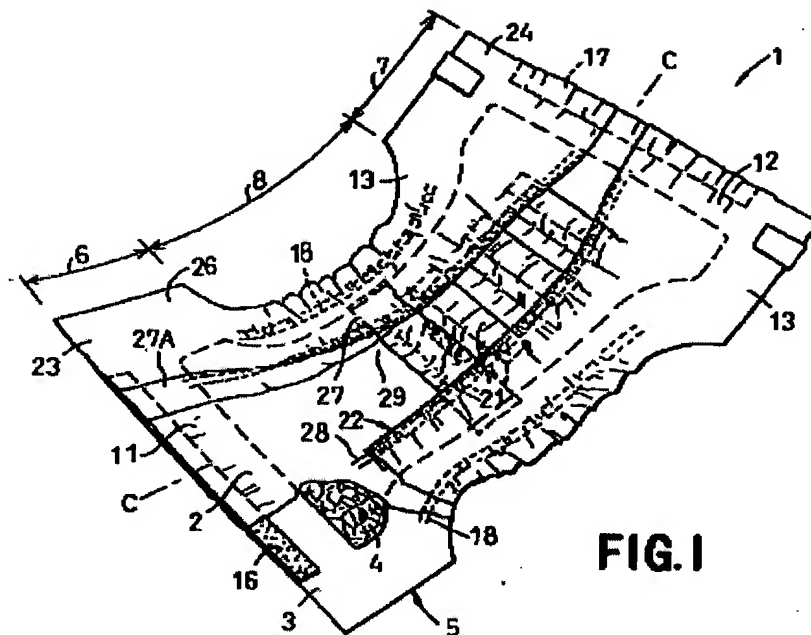


FIG.2

Regarding claim 2, Mishima *et al.* teach skin-contactable sheets (22) which comprise a pair of belt-shaped strips spaced apart from and opposed to each other in said transverse direction and respectively extending along said transversely opposite side edge portions (13) of said undergarment (1) in said longitudinal direction (C-C) so that said skin-contactable surface (2) inclusive of said liquid-absorbent panel (4) is partially exposed between the skin-contactable sheets (22)(see Fig. 1, below).

**FIG. 1*****Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Mishima *et al.* as applied to claims 1 and 2 above, and further in view of Van Rijswijck *et al.* (US 6,120,488 A).

Mishima *et al.* expressly teaches the claimed invention except for the skin-contactable sheets comprising elastically stretchable nonwoven fabric.

Van Rijswijck *et al.* teach side gasket flap members comprised of elastic nonwoven material (col. 14, lines 53-55).

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At the time of the invention, it would have been obvious to one of ordinary skill in the art to select the elastic nonwoven material of Van Rijswijck *et al.* to construct the barrier cuffs of Mishima *et al.* in order to provide the sheets with improved elastic qualities (Mishima *et al.* col. 2, lines 53-58).

Allowable Subject Matter

Claim 3 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. § 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bogart whose telephone number is (703) 605-1184. The examiner can normally be reached Monday-Friday.


In the event the examiner is not available, the examiner's supervisor, Weilun Lo may be reached at phone number (703) 308-1957. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 306-4520 for informal communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0858.

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Michael Bogart

May 17, 2003



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SUPERVISORY PATENT EXAMINER
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